

Serial No.: 10/079,935

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Claims 1-4, 6-11, 13, 14, 27, and 29-32 are pending in the present application.

Claims 1, 3, 10, 13, 14, 27, and 29 are amended to clarify the subject matter recited therein.

The amendments do not add new matter, and find support throughout the specification and figures. In particular, the amendments are supported by claim 3 of the preliminary amendment, the figures, and paragraphs 0033 and 0174 of the published application. A Request for Continued Examination accompanies this paper, and therefore it is respectfully requested that the amendments be entered. In view of the amendments and the following remarks, favorable reconsideration of this application is respectfully requested.

Initially, Applicants respectfully request the withdrawal of the finality of the Office Action based on the insufficiency of the Office Action to address the previously presented arguments for the allowability of dependent claim 9. The Examiner dismisses the argument presented in the most recent Amendment relating to the independent allowability of dependent claim 9, stating that "the dependent claim stands and falls with the corresponding independent claim" (Office Action; page 5, lines 1-2). However, this is a misstatement of the law. Each claim should be evaluated independently for patentability. Each dependent claim includes all of the features of its base claim, as well as the additional feature described therein. If the sole objection to claim 9 is its dependence from a rejected base claim, then the claim should be objected to, rather than rejected (see MPEP 706.01, stating in part "[i]f the form of the claim (as distinguished from its substance) is improper, an "objection" is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § 608.01(n)."). Applicants submit that the additional feature of claim 9, discussed below, is not disclosed or suggested in United States Patent No. 5,805,699 to Akiyama et al. (hereinafter Akiyama),

Serial No.: 10/079,935

and therefore Applicants request that the finality of the Office Action be withdrawn or alternatively that the claims be deemed allowable.

Claims 1-4, 6-11, 13, 14, 27, and 29-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of United States Patent Publication No. 2002/0176575 to Qawami et al. (hereinafter Qawami). Applicants respectfully traverse.

Claim 1 relates to a copy management system that includes, *inter alia*, a user terminal device, which comprises copy means for copying the content stored in the storage media to a first storage device, and which transmits device identification information attached to the user terminal device together with the unique media identification information of the storage media. In the copy management system of claim 1, the user terminal device deletes the copy enabling information after copying the content. The copy management system of amended claim 1 includes, *a second storage device disposed on the user terminal device and adapted to be attached to and removed from the user terminal device*. In amended claim 1, *the user terminal device transmits, as the device identification information, at least second device identification information attached uniquely to the second storage device*.

The present invention has the advantage of being able to prevent unauthorized copying of content, since the user terminal device cannot copy the content again after copying the content by the above constitution.

Applicants respectfully submit that neither of Akiyama nor Qawami disclose or suggest a second storage device disposed on the user terminal device and adapted to be attached to and removed from the user terminal device. Similarly, neither of the references disclose or suggest that the user terminal device transmits, as the device identification information, at least second device identification information attached uniquely to the

Serial No.: 10/079,935

second storage device. The specification discusses the use of a second storage media, stating:

A computer program may include, for examples game content, music content, movie content, or an application program. A storage media recorded with a computer program may include an optical disk such as a DVD-ROM or CD-ROM as well as semiconductor memory. *Secondary storage media upon which a copy of a computer program is stored may include, for example, a hard disk (HD), DVD-RAM, and a magneto-optical disk (MO).*

(Specification; paragraph 0033; emphasis added). The specification further discusses an advantage of the system according to the present invention, as regards a second storage media, stating:

Since the above-mentioned third party is not able to acquire the Content-Key, he/she will not be able to decrypt the content stored on the borrowed disk. Accordingly, even if the above-mentioned third party is able to copy the content onto a secondary storage media such as a HDD, such content cannot be used since he/she is not able to decrypt such contents. Accordingly, this copy management system is able to prevent unauthorized use of content.

(Specification; paragraph 0174). In contrast, Akiyama and Qawami apparently discuss a software copying system and a playback device, respectively. Neither of the references disclose or suggest a *second storage media*, or more particularly that *a user terminal device transmits device identification information including a unique identification of the second storage media*. Therefore, the combination of the references, the propriety of which is respectfully not conceded (see below), does not render the claims unpatentable.

Furthermore, the motivation to combine the references is improper. The Examiner indicates that the motivation to combine the references provided in the previous Office Action is sufficient. The Examiner asserts the previously presented motivation to combine the references, namely to "limit the number of times the content can be used," (Office

Serial No.: 10/079,935

Action; page 7, lines 4-5). This appears to be merely a restatement of an advantage of the present invention, and does not appear to be supported by either reference. Akiyama is directed to a software copying system that the Examiner acknowledges *does not disclose deleting the copy enabling information* after copying the content. Qawami, in contrast, relates to a software system directed to a *decrypting content*. However, Qawami does not appear to disclose or suggest that the feature of deleting keys relates in any way whatsoever to *limiting the number of times content can be used*. Therefore, the combination of the references is improper and the result of hindsight reasoning.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in *Teleflex, Inc. et al. v. KSR Int'l Co.*, (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some*

Serial No.: 10/079,935

motivation to combine the prior art teachings in the particular manner claimed."

(*Teleflex*, citing *In re Kozab*; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Qawami to combine its teaching with the Akiyama. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, the combination of the references is improper and the result of hindsight reasoning, and the rejection of claim 1 should be withdrawn.

Independent claims 10, 27, and 29 are also rejected on the basis of the combination of the references. Therefore, for at least the same reasons as claim 1 is allowable, claims 10, 27, and 29 are also allowable.

The dependent claims are allowable for at least the same reasons as their respective base claims are allowable.

Additionally, claim 9 includes the feature of an intermediating server device which intermediates in the transmission/reception of information between the user terminal device and the server device, and which performs charge processing for the user at least when copy enabling information is transmitted to the user terminal device. The Examiner asserts that the feature of claim 9 is disclosed in Akiyama based solely on figure 8 including a "request for billing". (Office Action; page 10, section 12). There is no indication in Akiyama that the "request for billing" in figure 8 is performed by an *intermediating server device*, nor does Akiyama disclose a server intermediating between the transmission and reception of information that performs charge processing. It does not appear that any of the references disclose or suggest the features of claim 9, and therefore for at least this additional reason claim 9 is allowable.


Serial No.: 10/079,935

Similarly, claims 30-32 include features similar to those discussed above in regard to claim 9, and therefore each of these claims is allowable for at least the same reasons as claim 9 is allowable.

In view of the amendments and remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,


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